

REMARKS

Following entry of the Amendment, claims 1-5, 7-12, 14-19, 21, 22 and 25 are pending in the above-identified application. Claims 10-14 are rejected under 35 U.S.C. §112, ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Claims 1-5, 7-12, 14-19, 21, 22 and 25 are rejected under 35 U.S.C. §102(e) as being anticipated by Gulati et al. (U.S. Pat. No. 6,924,827; hereinafter referred to as "Gulati"). Claims 6, 13, 20 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gulati in view of Denoue et al. (U.S. Pat Pub. No. 2003/0051615).

Claims 6, 13, 20, 23 and 34 have been canceled. Claims 1, 8, 10-12, 13-15, 21 and 25 have been amended. Applicants submit that these amendments and remarks overcome all of the Examiner's outstanding rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

Rejections Based on §112, ¶2

Claims 10-12 and 14 are rejected under 35 U.S.C. §112, ¶2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Claims 10-12 and 14 have been amended to correct a typographical error, specifically substituting the word "system" for "method." Applicants believe this addresses the issues raised in the O.A. and, therefore, respectfully request withdrawal of the §112, ¶2 rejections of claims 10-12 and 14.

Rejections Based on §102(e)

Claims 1-5, 7-12, 14-19, 21-23 and 25 are rejected under 35 U.S.C. §102(e) as being anticipated by Gulati et al. (U.S. Pat. No. 6,924,827; hereinafter referred to as "Gulati"). Claims 1, 8, 15 and 21 have been amended to incorporate elements of claims 6, 13, 20 and 24, respectively. Claim 25 has also been amended to incorporate a similar element. Therefore, the remarks below associated with the §103(a) rejections now apply and the Applicant respectfully request withdrawal of the §102(e) rejections of claims 1-5, 7-12, 14-19, 21-23 and 25.

Rejections Based on §103(a)

Claims 6, 13, 20 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gulati in view of Denoue et al. (U.S. Pat Pub. No. 2003/0051615). Claims 6, 13, 20 and 24 have been canceled and the claimed subject matter incorporated into independent claims 1, 8, 15 and 21, respectively. In addition, claim 25 has been amended to incorporate a similar element. The following remarks are therefore directed at amended claims 1, 8, 15, 21 and 25.

The current Office Action (O.A.) concedes that "Gulati et al. does not teach 'inserting the metadata into a second destination document rather than the first destination document, wherein the second destination document is associated with the first destination document'" (O.A., p. 12, note 9, lines 6-8). The O.A. relies upon Denoue for this particular element. However, Denoue neither teaches nor suggests this element. Rather, Denoue is directed to an "identifier" by means of which metadata may be retrieved in association with an information object. The O.A. states that an "identifier" implies a second destination document. Applicant contends that an "identifier" does not necessarily imply a second destination document and, in fact, Denoue does not teach or suggest this element. For example, an identifier may describe the original location of the metadata and, therefore, does not describe a second destination document.

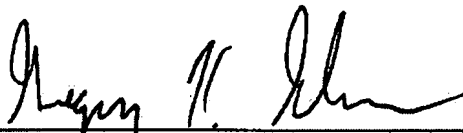
To establish *prima facie* obviousness of a claimed invention under §103(a), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “**All words in a claim must be considered** in judging the patentability of that claim against prior art.” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970); *emphasis added*). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 1, 8, 15, 21 and 25 are allowable over the cited art. In addition, claims 2-7, 9-14, 16-20 and 22-24 are allowable because they each depend upon one of the allowable independent claims.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. A Request for a One-Month Extension of Time is being filed and paid for electronically in conjunction with this Response so that Applicants have until September 10, 2007 to respond. It is believed that no other fees are due with the filing of this Amendment/Response. However, should any other fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

Date: September 10, 2007

A handwritten signature in black ink, appearing to read "Gregory K. Goshorn", written over a horizontal line.

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